



Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
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spg
Paper Number #8

In re application of :
Mark Wang et al. : DECISION ON
Serial No. 09/547,395 : PETITION
Filed: April 11, 2000 :
For: THREE-DIMENSIONAL OPTICAL DATA STORAGE :
IN FLUORESCENT DYE-DOPED PHOTOPOLYMER :

This is a decision on the PETITION UNDER C.F.R. §8(b) (NO FEE) TO WITHDRAW HOLDING OF ABANDONMENT ON THE BASIS THAT A REQUIRED RESPONSE WAS TIMELY MAILED, filed February 19, 2003. The petition requests that the holding of abandonment, as set forth in the Notice of Abandonment mailed December 9, 2002, for failure to timely file a proper response to the Office letter mailed on April 22, 2002 be withdrawn since the applicant did timely file a response on August 19, 2002 (a copy of the AMENDMENT UNDER 37 C.F.R. §116 filed August 19, 2002 is attached to the instant petition).

DECISION

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 C.F.R. § 1.181 (no fee) - no abandonment-in-fact.

A review of the evidence presented reveals that the applicant did file a response entitled AMENDMENT UNDER 37 C.F.R. §116 on August 19, 2002 to the Final Rejection mailed April 22, 2002, which set a shortened statutory period for response thereto of three months from the mailing date thereof. The Final Rejection, mailed April 22, 2002, also clearly states that "Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)." The rejection also states "In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action." A review of the instant application file indicates that the AMENDMENT UNDER 37 C.F.R. §116 originally filed on August 19, 2002 has not been matched with the file.

37 C.F.R. 1.116 (b) states:

"§ 1.116 Amendments after final action or appeal.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for

in paragraph (d) of this section.” (emphasis added)

37 CFR 1.113 states:

“§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, **whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116.** Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). **Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section.** For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.” (Emphasis added)

37 CFR 1.114 states:

“§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
- (4) An application for a design patent; or
- (5) A patent under reexamination.

[Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000]”

Whether or not applicant's reply was received at the USPTO and matched with the instant application file, given the finality of the rejection in the instant application, the only courses of

action available to the applicant as the end of the 6-month statutory period approached, given the above rules, would have been:

- (1) To file an amendment, and ensure that it was matched with the file and considered by the Examiner, with the proper extension of time fee, under 37 C.F.R. 1.116, which placed the application in condition for allowance, see MPEP 706.07(f);
- (2) File a notice of appeal with the proper extension of time fee, see MPEP 1205;
- (3) File a continuing application under 37 C.F.R. 1.53(b) or (d), see MPEP 201.06(c) and (d),
- (4) File a request for continued examination under 37 C.F.R. 1.114, or;
- (5) Abandon the application.

While the Office attempts to promptly match with the application file and respond to an amendment after final, there are those instances where delays do occur, as in the instant application. However, it is clear from 37 C.F.R. 1.116 that abandonment of an application is risked when an amendment after a final Office action is proffered by the applicant. The rule clearly indicates that the mere filing of an amendment does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment. Therefore, whether the petitioner's reply was received and matched with the instant application file or not prior to the expiration of the six month statutory period, the only right petitioner was entitled to was that of appealing the final rejection or by filing a continuing application or request for continued examination. This application became abandoned for failure on the part of petitioner to file an appeal or a continuing application or request for continued examination. Petitioner has not stated what steps were taken to maintain pendency of the application after the filing of the response on August 19, 2002 in view of the terms set out in 37 C.F.R. 1.116. When applicants did not receive a response before the expiration of the six month statutory period to respond to the final Office action of April 22, 2002, the appropriate action would have been to (1) inquire as to the status of the application, or (2) file a Notice of Appeal (or a continuing application or request for continued examination) to maintain pendency of the application.

This application became abandoned by operation of law (35 U.S.C. 133) for applicants' failure to timely file a Notice of Appeal in response to the outstanding final rejection. See Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 30 (CCPA 1964).

The applicants are advised that if a petition under 37 C.F.R. 1.137(a) or (b) is filed, then such a petition should be accompanied by a:

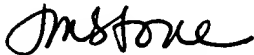
- (1) NOTICE OF APPEAL and pay the required notice of appeal fee, which is set by 37 C.F.R. 1.17(e). An appeal brief would be due two (2) months from the date of filing the notice of appeal, but the due date can be extended up to five (5) months with payment of extension of time fees, or a;**
- (2) Request for a continuation application under 37 C.F.R. 1.53(b) with the appropriate filing fee and the document required by the rule, or file a continued prosecution application (CPA) request under 37 C.F.R. 1.53(d) with the appropriate filing fee if the applicants want to continue prosecution of the application using the same application as already presented. Either of these options should also be filed with an amendment to the claims, or a;**

(3) Request for continued examination under 37 C.F.R. 1.114 with the appropriate filing fee and submission required by the rule, and a;

(3) Terminal Disclaimer, pursuant to 37 C.F.R. 1.137(c).

The holding of abandonment, set forth in the Notice of Abandonment of July 2, 2001 was proper and is maintained.

The petition is **DENIED**.



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